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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,411	11/07/2001	Travis J. Parry	10013282-1	4329

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/053,411	PARRY, TRAVIS J.	
	Examiner	Art Unit	
	Joseph R. Pokrzywa	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/27/06 has been entered.

Response to Amendment

2. Applicant's amendment received on 1/27/06 has been entered and made of record. Currently, **claims 1-13 and 16-20** are pending.

Response to Arguments

3. Applicant's arguments, see pages 7-11, filed 1/27/06, with respect to the rejection(s) of claim(s) 1-13 and 16-20 under 35 U.S.C. 102(e) as being anticipated by Choksi *et al.* (U.S. Patent Number 6,477,243) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Young *et al.* (U.S. Patent Application Publication 2004/0205115).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claim 4** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, dependent **claim 4** recites the broad recitation "a group consisting of an embedded web server printer and a web browser enabled printer", and independent **claim 1** also recites "a group consisting of: e-mail enabled printers, embedded web server printers, e-mail enabled print servers, and web browser enabled printers", which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 1-13, and 16-20** are rejected under 35 U.S.C. 102(e) as being anticipated by Young *et al.* (U.S. Patent Application Publication 2004/0205115).

The applied reference has a common assigned with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Regarding **claim 1**, Young discloses a method of distributing a facsimile (see abstract), the method comprising receiving the facsimile (paragraphs 0015-0019), storing the facsimile on a storage media at a specific location (paragraphs 0016-0019), identifying an Internet enabled device associated with each intended recipient of the facsimile (paragraphs 0019-0023), the Internet enabled device independently selected from a group consisting of e-mail enabled printers, embedded web server printers, e-mail enabled print servers, and web browser enabled printers (paragraphs 0016, 0026, and 0031), and notifying each identified Internet enabled device of the specific location for the saved facsimile (paragraphs 0023-0027).

Regarding *claim 2*, Young discloses the method discussed above in claim 1, and further teaches that the notifying each identified Internet enabled device of the specific location for the saved facsimile comprises sending the Internet enabled device an e-mail identifying the specific location for the saved facsimile (paragraphs 0023-0027).

Regarding *claim 3*, Young discloses the method discussed above in claim 1, and further teaches of using the Internet enabled device to retrieve the saved facsimile from the specific location, and printing the facsimile (paragraphs 0025 and 0029).

Regarding *claim 4*, Young discloses the method discussed above in claim 1, and further teaches that the Internet enabled device is selected from the group consisting of an embedded web server printer and a web browser enabled printer (paragraphs 0016, 0026, and 0031).

Regarding *claim 5*, Young discloses a method of distributing a facsimile (see abstract), the method comprising sending the facsimile to a registered address (paragraphs 0017-0018), retrieving the facsimile (paragraphs 0019-0024), determining a set of intended recipients for the facsimile from the registered address (paragraphs 0019-0023), saving the facsimile to a specific storage location on a storage media (paragraphs 0016-0024), and notifying each of the set of intended recipients via an Internet enabled device or via facsimile of the saved facsimile and the specific storage location for retrieving the facsimile (paragraphs 0023-0027), the Internet enabled device independently selected from a group consisting of e-mail enabled printers, embedded web server printers, e-mail enabled print servers, and web browser enabled printers (paragraphs 0016, 0026, and 0031).

Regarding *claim 6*, Young discloses the method discussed above in claim 5, and further teaches that the registered address is associated with a facsimile distribution center (paragraphs 0016-0022).

Regarding *claim 7*, Young discloses the method discussed above in claim 6, and further teaches that the facsimile distribution center comprises a computer program for receiving facsimiles, sending facsimiles, sending e-mails, and determining intended recipients for saved facsimiles (paragraphs 0016-0027).

Regarding *claim 8*, Young discloses the method discussed above in claim 5, and further teaches that the registered address is selected from the group consisting of phone numbers, e-mail addresses, and URL addresses (paragraphs 0020-0027).

Regarding *claim 9*, Young discloses the method discussed above in claim 5, and further teaches that determining a set of intended recipients from the registered address comprises querying a database for determining a set of intended recipients (paragraphs 0020-0024).

Regarding *claim 10*, Young discloses the method discussed above in claim 9, and further teaches that querying a database for determining a set of intended recipients comprises querying the database with the registered address to determine at least one recipient contact information address associated with the registered address (paragraphs 0020-0024).

Regarding *claim 11*, Young discloses the method discussed above in claim 10, and further teaches that the recipient contact information address is selected from the group consisting of phone numbers, e-mail addresses, and URL addresses (paragraphs 0020-0027).

Regarding *claim 12*, Young discloses the method discussed above in claim 10, and further teaches that querying a database for determining a set of intended recipients further

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comprises querying the database with the registered address to determine at least one recipient name associated with the registered address (paragraphs 0020-0024).

Regarding *claim 13*, Young discloses the method discussed above in claim 5, and further teaches that saving the facsimile to a specific storage location on a storage media comprises saving the facsimile to a storage media associated with a URL address, and assigning a unique path name to the saved facsimile (paragraphs 0020-0025, and 0029).

Regarding *claim 16*, Young discloses the method discussed above in claim 5, and further teaches that notifying each of the set of intended recipients of the saved facsimile via an Internet enabled device comprises notifying the Internet enabled device of the specific storage location for retrieving the facsimile, and activating the Internet enabled device to retrieve the facsimile from the specific storage location (paragraphs 0020-0025, and 0029).

Regarding *claim 17*, Young discloses the method discussed above in claim 16, and further teaches of printing the facsimile at the Internet enabled device (paragraphs 0020-0025, and 0029).

Regarding *claim 18*, Young discloses a system for distributing facsimiles (see Fig. 1), the system comprising a facsimile distribution center for receiving facsimiles (service provider 110, paragraphs 0015-0019), saving facsimiles (paragraphs 0016-0019), and sending notification messages to at least one Internet enabled device (paragraphs 0023-0027), the Internet enabled device independently selected from a group consisting of e-mail enabled printers, embedded web server printers, e-mail enabled print servers, and web browser enabled printers (paragraphs 0016, 0026, and 0031), a storage media for storing facsimiles saved by the facsimile distribution center

(paragraphs 0021-0025), and a database for determining intended recipients for received facsimiles (mapping table 118, paragraphs 0021-0022).

Regarding *claim 19*, Young discloses the system discussed above in claim 18, and further teaches that the facsimile distribution center comprises at least one computer program for receiving facsimiles, accessing the database to determine the at least one Internet enabled device associated with at least one intended recipient of the facsimile, and notifying the at least one Internet enabled device of the facsimile by email (paragraphs 0020-0029).

Regarding *claim 20*, Young discloses the system discussed above in claim 18, and further teaches that the facsimile distribution center comprises at least one computer program for receiving facsimiles, saving facsimiles, and sending notification messages, and at least one communications port for communicating with the Internet or a phone line (paragraphs 0020-0035).

Citation of Pertinent Prior Art

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Parry (U.S. Patent Application Publication 2002/0131071) discloses a web browser enabled printer that retrieves a stored fax document; and

Matsubayashi et al. (U.S. Patent Number 6,938,202) discloses a system for retrieving and printing network documents.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Primary Examiner
Art Unit 2625



jrj